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•Admitted only in Virginia
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March 14, 2003

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Art Unit 1652

MAR 17 2003

TECH CENTER 1600/2900

Commissioner for Patents
Washington, D.C. 20231

Re: U.S. Utility Patent Application
Appl. No. 09/974,973; Filed: October 12, 2001
For: **Feedback-Resistant Pyruvate Carboxylate Gene from *Corynebacterium***
Inventor: Paul D. HANKE
Our Ref: 1533.1230001/MAC/RGM

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Reply To Restriction Requirement; and
2. Return Postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Michele A. Cimbala
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Attorney for Applicant
Registration No. 33,851

MAC/RGM:krm

Enclosures

SKGF_DC1:111048.1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Paul D. HANKE

U.S. Appl. No. 09/974,973

Filed: October 12, 2001

For: **Feedback-Resistant Pyruvate
Carboxylate Gene from
*Corynebacterium***

Confirmation No. 8115

Art Unit: 1652

Examiner: Slobodyansky, E.

Atty. Docket: 1533.1230001/MAC/RGM

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TECH CENTER 1600/2900

Reply To Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action, dated February 14, 2003, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1, 2, 5-8, 12, 13, 19, 20 and 3, drawn to a DNA encoding a polypeptide having the amino acid sequence of SEQ ID NO:2 and fragments thereof, a vector and a host cell comprising thereof and a method of making a host cell, classified in class 435, subclass 463. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed. This election is made with traverse.

The Examiner alleges that Groups I-V are patentably distinct inventions. However, even where patentably distinct inventions appear in a single application, restriction remains improper unless the Examiner can also show that the search and examination of the groups would entail a "serious burden." It is only where the inventions are independent, that the "serious burden" is inherent and need not be explained by the Examiner (see MPEP § 803 and 808). In the present application, the Examiner has failed to show that the search and examination of the groups would entail a serious burden. With respect to Groups I, II and IV, V, Applicants submit that a search of either the nucleotide sequence or polypeptide claims

would provide useful information for the remaining claims. Disclosure of the nucleotide inherently describes the predicted polypeptide. Furthermore, many, if not most, publications where a published nucleotide sequence is described, the authors also include, as a matter of routine, the amino acid sequence. Thus, a search for information from restriction groups I and II will result in a significant amount of information related to restriction groups IV and V, and vice-versa.

Finally, the Examiner states that Group III is patentably distinct from Groups I, II, IV and V because it is drawn to methods of making of a product that is neither used by nor produced by Groups I, II, IV and V. Applicants respectfully submit that the two prerequisites to proper restriction are that the inventions must be independent or distinct as claimed, and that examination of the inventions would create a "serious burden" (see MPEP § 803 and 808). Where the inventions are related but patentably distinct, as the Examiner alleges in the present application, the "serious burden" must be explained by the Examiner; and the Examiner has failed to show that the search and examination of the groups would entail a serious burden.

Applicants submit that the application is fully in condition for examination. An examination on the merits is earnestly solicited.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

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